

REMARKS

Claims 1-22 are presently pending. A listing of the claims (without amendments) is presented for the Examiner's convenience. The following addresses the substance of the Office Action.

Obviousness

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Obie et al. (WO 01/35719) in view of Payne (Organic Coating Technology. Vol. I. "Oils, resins, varnishes, and polymers," Henry Fleming Payne, Wiley, New York; Chapman & Hall, London, 1954). Obie et al. discloses a wood stain formulation that comprises carboxymethyl cellulose, butyl benzyl phthalate, surfactants, calcium carbonate and titanium dioxide, the reference does not disclose alkaline earth metal salts of aliphatic acids. Payne et al. discloses metallic soaps, such as magnesium stearate, as flattening agents.

The Examiner noted that the Supreme Court stated in KSR Int'l Co. v. Teleflex Inc., 550 U.S. __ (2007): "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." However, as described below, the presently recited combination yields unexpected, rather than predictable, results.

Unexpected Results

As set forth in MPEP 2145, rebuttal evidence against alleged *prima facie* obviousness may include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art. As evidence of non-obviousness, the presently claimed dispersions have the following unpredictable advantages over the prior art.

1. The present claimed compositions are suitable for application to polyethylene (PE), metal and composite substrates (see page 32, lines 1-2 and page 32, lines 27-29 of the subject specification);
2. The present claimed invention has excellent adhesion (see Example 6, pages 30-31 of the subject specification);
3. The present claimed invention has excellent adhesion after accelerated weather testing (see Example 6, page 31 of the subject specification);
4. The present claimed invention has excellent integrity in field testing (Example 6, page 31 of the subject specification); and

5. The present claimed invention may be applied to existing PE substrates and need not be incorporated at the time of article manufacturing, i.e., they may be applied to existing goods.

As explained below, the compositions described in the cited documents do not have these unpredictable advantages. As such, the unexpected advantages refute any alleged *prima facie* obviousness.

Surprisingly, the presently claimed compositions may be applied to PE, metal and composite substrates. On the other hand, dispersions and primers of the prior art simply can not be applied to PE, metal and composite substrates, or they require expensive pre-application coatings or treatments. Thus, the claimed invention makes possible something that is highly desirable, which the compositions of the cited references simply can not accomplish.

The highly desirable advantages of the present claimed invention could not have been predicted from the prior art. For example, neither of the cited references provide any expectation that the present claimed invention would be suitable for application to PE, metal and composite substrates. While Obie is directed to adhesion to wood and to an overcoat, Payne merely teaches a flattening agent as used to reduce the mirror or specular reflectance. Based on these references, a skilled person would have had no expectation that the presently claimed compositions would adhere to PE.

As noted by the Examiner, Obie fails to teach or suggest an alkaline earth metal salt of a C₉-C₂₀ aliphatic fatty acid. As a direct result of this shortcoming, Obie is not able to achieve the above-outlined advantages of the presently claimed compositions. This is clear from the teachings of Obie, which are exclusively directed to a stain composition for staining a wood substrate. Obie would not have limited his disclosure to wood substrates if the composition could be used for impenetrable materials, such as PE, metal and composite substrates. To overcome the shortcomings of Obie, the Examiner has cited Payne as teaching a metallic soap. However, Payne teaches numerous examples of flattening agents. One of ordinary skill in the art would have had not have reasonably expected that the combined teachings of Obie and Payne to specifically combine the compositions of Obie with an alkaline earth metal salt of a C₉-C₂₀ aliphatic fatty acid as required by the pending claims.

In conclusion, the combination of familiar elements did not simply yield predictable results. Instead, the presently claimed compositions have unexpected advantages over the prior art, and

are therefore nonobvious. These advantages are a direct result of the claimed components including an alkaline earth metal salt of a C₉-C₂₀ aliphatic fatty acid. A skilled person would not have arrived at the presently claimed compositions based on the teaching of the prior art. In view of the foregoing, the Applicant has made a significant advancement over the state of the art and should be rewarded for their contribution. Accordingly, the Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In view of the preceding Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Application No.: 10/591,313
Filing Date: July 23, 2007

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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